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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,864	01/16/2001	Mika Partain	2271/63926	4206
7590	12/22/2005		EXAMINER	
Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/760,864	PARTAIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew S. Gart	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 and 22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 and 22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 31 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/2005 has been entered.

***Prosecution History***

Claim 21 was canceled via the submission filed 9/26/2005.

Claim 22 was added via the submission filed 9/26/2005.

Claims 1-20 and 22 are currently pending in the instant application.

***Drawings***

The drawings were received on 31 March 2004. The Examiner accepts these drawings.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin et al. (U.S. Patent No. 6,078,897) in view of Peirce et al. (U.S. Patent No. 6,332,126).**

Referring to claim 1. Rubin discloses a method of promoting product sales in Internet transactions (Rubin: at least Abstract) comprising:

- Delivering display information to a customer side for ordering products by entering order information at the customer side for transmission to a seller side via the Internet (Rubin: at least column 3, lines 59-65);
- In response to an initial order entered at the customer side for a specified product and a specified quantity thereof that is in a first selected range, delivering order processing information to the customer side for said initial order (Rubin: at least column 3, line 59 to column 4, line 31);
- Delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, only if the specified quantity of the specified product is within a second range that is higher than a minimum quantity and the first range (Rubin: column 1, lines 44-53); and

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- In response to an entry of a first revised order at the customer side conforming to the first promotion, delivering to the customer side order processing information for said first revised order (Rubin: at least Abstract).

Rubin does not expressly disclose delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, wherein no promotion is displayed at the customer side if the specified quantity does not meet or exceed the minimum quantity. Pierce discloses delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, wherein no promotion is displayed at the customer side if the specified quantity does not meet or exceed the minimum quantity (Pierce: at least column 14, lines 35-40). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Rubin to have included the teachings of Pierce et al. in order to allow merchants to effectively market their products and services (Pierce: column 1, lines 32-39).

Even though Rubin in view of Pierce discloses all the limitations of claim 1 as indicated supra, the Examiner notes, the "wherein" clause as used above merely states the result of the limitation in the claim. The wherein clause does not relate back to or clarifies what is required by the claim and is therefore given little patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed.

Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

The Examiner further notes, the phrases “only if the specified quantity of the specified product is within a second range...” and “if the specified quantity does not meet or exceed the minimum quantity...” does not move to distinguish the claimed invention from the reference (Rubin et al.). These phrases are both conditional limitations. The noted “if” steps are not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Referring to claim 2. Rubin further discloses a method including responding to an initial order entered at the customer side for a specified product and quantity thereof that is in a third range higher than the second range by delivering to the customer side display information indicative of at least a second promotion that is different from the first promotion and is functionally related to the initial order that is in said second range; and in response to an entry of a second revised order at the customer side conforming to the second promotion, delivering to the customer side order processing information for said third revised order (Rubin: at least Fig. 3).

Referring to claim 3. Rubin further discloses a method in which said first promotion is for a retail sales transaction and said second promotion is for a business-to-business transaction (Rubin: at least column 1, lines 26-53).

Referring to claim 4. Rubin further discloses a method in which said information indicative of a first promotion includes information regarding a difference between the initial order quantity and a quantity for qualifying for the first promotion (Rubin: at least Abstract).

Referring to claim 5. Rubin further discloses a method in which said customer side and seller side are at geographically remote locations (Rubin: at least column 1, line 26 to column 2, line 20).

Referring to claims 6-14. Claims 6-14 are rejected under the same rationale as set forth above in claims 1-5.

Referring to claims 15-19. Claims 15-19 are rejected under the same rationale as set forth above in claims 1-5.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claims 1-5.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claims 1-5.

***Response to Arguments***

Applicant's arguments filed 9/26/2005 have been fully considered but are moot in view of the new grounds for rejection.

The applicant argues that Rubin does not disclose the displaying of promotional information

- (a) only if the initial order meets or exceeds a minimum quantity, and
- (b) no promotion information is displayed if the initial order does not meet or exceed the minimum quantity.

The Examiner notes, Rubin discloses a method and apparatus wherein some orders for products are discounted based on a volume related to the amount of products in the order. If a certain volume of products is ordered together, a volume discount applies. A larger discount may be available for orders of larger volumes. The discount is calculated by determining the highest volume discount threshold that does not exceed the volume of the order. For example, orders with a volume of at least 50 might receive a 10% discount and orders with a volume of at least 100 might receive a 15% discount. The thresholds are 50 and 100 (Rubin: column 1, lines 44-53). Therefore Rubin discloses the use of volume thresholds, which are applied to an order only if the order meets or exceeds a certain minimum volume.

Rubin does not expressly disclose delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, wherein no promotion is displayed at the customer side if the specified quantity does not meet or exceed the minimum quantity. Pierce discloses delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, wherein no promotion is displayed at the customer side if the specified quantity does not meet or exceed the minimum quantity (Pierce: at least column 14, lines 35-40). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Rubin to have included the teachings of Pierce in order to allow merchants to effectively market their products and services (Pierce: column 1, lines 32-39).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG  
Patent Examiner  
December 16, 2005